



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,470	09/14/2005	Masaru Shimizu	YMMRP0101US	8307
43076 7590 04/07/2009 MARK D. SARALINO (GENERAL) RENNER, OTTO, BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE, NINETEENTH FLOOR CLEVELAND, OH 44115-2191				
EXAMINER KOCH, GEORGE R				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
04/07/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,470

Applicant(s)

SHIMIZU ET AL.

Examiner

George R. Koch III

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/DE)
Paper No(s)/Mail Date 9/14/2005; 4/9/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umebayashi (US 202/0174930 A1) in view of Pisani (US 3,759,198).

As to claim 1, Umebayashi discloses a folding apparatus (Figure 1 and 2), comprising: a folding section (item 40) for folding a web in two so that opposite side edges of the web are in a predetermined positional relationship with respect to each other (as shown in Figures 1 and 2); a detecting section (sensors 41; see paragraphs 0048-50; see also paragraphs 0051-0062) for detecting a reference portion of the web to be used as a reference in a web folding operation so as to output positional information regarding a position of the detected reference portion; and a control section (such as a compensator, modern control, or fuzzy control) for controlling the correction section based on the positional information so as to bring a positional relationship between the opposite side edges of the web closer to the predetermined positional relationship (see, for example, paragraphs 0054-59). See especially claims 9, which recites “apparatus for producing a disposable worn article, comprising: a folding section comprising a contact member that contacts a web for folding the web in two so that opposite side edges of the web are in a predetermined positional relationship with respect to each other; a correcting section for correcting the positional relationship between the web being carried to the folding section and the contact member; a detecting section for detecting a reference portion of the web to be used as a reference in the folding operation so as to output positional information regarding a position of the detected reference portion; and a controller for controlling the correction of the positional relationship by the correcting section based on the positional information.”

Umebayashi does not disclose a correction section for correcting a moving direction of the web *by contacting the web in the folding section*. Umebayashi only discloses that the

correcting section is for correcting the positional relationship between the web being carried to the folding section and the contact member.

However, Pisani does not disclose a correction section (item 45, best shown in Figure 3) for correcting a moving direction of the web by contacting the web (via drawing roller 66) in the folding section (generally, the folding section is the triangular frame). Pisani also uses a detecting section (such as photocell 38) and independent control (column 4, lines 39-40) which also operates to control the correction section based on the positional information so as to bring a positional relationship between the opposite side edges of the web closer to the predetermined positional relationship. Pisani also discloses a number of benefits and motivations for utilizing this invention; namely that the invention reduces the dimensions of the apparatus, reduces the need for operator involvement, and reduces ruffles in the fabric or web (see column 6, lines 7-19). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have utilized the correction section of Pisani in order to achieve the benefits of reduced dimensions of the apparatus, reduced need for operator involvement, and reduced ruffles in the fabric or web.

As to claim 2, Umebayashi discloses that the correction section corrects a moving direction of the web by altering a tension of the web (see paragraph 0019, 0045-47, 0062 and 0065).

As to claim 3, Umebayashi discloses a folding apparatus (Figure 1, 2) for folding in two a continuous web being continuous in a running direction of the web so that opposite side edges of the web are in a predetermined positional relationship with respect to each other, the apparatus

comprising: an abutting member (folding sailor 1) provided so as to extend in the running direction between the opposite side edges of the web, wherein the abutting member abuts against the web to fold the web into a V or U shape (as a result of the folding sailor); a nipping member (such as guide bars 51) provided downstream of the abutting member for nipping the web folded by the abutting member so as to fold the web in two; a detecting section (such as sensors 41, see Figure 2) for detecting a reference portion of the web to be used as a reference in a web folding operation so as to output positional information regarding a position of the detected reference portion; and a control section for controlling based on the positional information so as to bring a positional relationship between the opposite side edges of the web closer to the predetermined positional relationship (see, for example, paragraphs 0054-59, and see especially claims 9, which recites the folding section, detecting section, and controller).

Umebayashi does not disclose a contact section provided between an upstream end of the abutting member and the nipping member for contacting an inner surface and/or an outer surface of the web being folded in the V or U shape a driving section for changing a state of contact of the contact section and/or the abutting member with the web, or that the control section for controlling an action of the driving section.

However, Pisani discloses a contact section (elements 45) provided between an upstream end of the abutting member and the nipping member for contacting an inner surface and/or an outer surface of the web being folded in the V or U shape, a driving section (such as electromagnets 69 and driving reduction unit 63 and 64, and the associated subelements of Figure 3) for changing a state of contact of the contact section and/or the abutting member with the web, and that the control section for controlling an action of the driving section. Pisani also

uses a detecting section (such as photocell 38) and independent control (column 4, lines 39-40) which also operates to control the correction section based on the positional information so as to bring a positional relationship between the opposite side edges of the web closer to the predetermined positional relationship. Pisani also discloses a number of benefits and motivations for utilizing this invention; namely that the invention reduces the dimensions of the apparatus, reduces the need for operator involvement, and reduces ruffles in the fabric or web (see column 6, lines 7-19). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have utilized the correction section of Pisani in order to achieve the benefits of reduced dimensions of the apparatus, reduced need for operator involvement, and reduced ruffles in the fabric or web.

As to claim 4, Umabayashi discloses a method for producing a worn article, the method comprising the steps of: placing an absorbent body on a surface of a web (see paragraph 0031; see Figure 1, placing section 10 and drum 11); folding the web in two (see paragraph 0033-34) in a folding section (folding section 40, folding sailor 1) so that opposite side edges of the web are close to or aligned with each other; detecting a reference portion of the web to be used as a reference in a folding operation to generate positional information regarding a position of the detected reference portion; bonding portions of the folded web to each other to form a bonded portion (see paragraph 0036, see drum 61); and cutting the bonded web along the bonded portion (see paragraph 0036 as well, the same structure that performs the bonding also performs the cutting). See also claim 1 of Umabayashi, which “a method for producing a disposable worn article, comprising the steps of: placing an absorbent on a surface of a web; folding the web in

two so that opposite side edges of the web are brought close to each other or laid on each other; detecting a reference portion of the web to be used as a reference in the folding operation so as to generate positional information regarding a position of the detected reference portion; correcting a path of the web based on the positional information so that the opposite side edges of the folded web are in a predetermined positional relationship with respect to each other; bonding portions of the folded web to each other so as to form a bonded portion; and cutting the bonded web along the bonded portion.”

Umabayashi does not disclose correcting a path of the web based on the positional information so that the opposite side edges of the folded web are in a predetermined positional relationship with respect to each other *by bringing a contact section into contact with the web in the folding section*;

However, Pisani discloses a correcting a path of the web based on the positional information so that the opposite side edges of the folded web are in a predetermined positional relationship with respect to each other *by bringing a contact section into contact with the web in the folding section* by use of a contact section (elements 45) which provided between an upstream end of the abutting member and the nipping member for contacting an inner surface and/or an outer surface of the web being folded in the V or U shape, a driving section (such as electromagnets 69 and driving reduction unit 63 and 64, and the associated subelements of Figure 3) for changing a state of contact of the contact section and/or the abutting member with the web, and that the control section for controlling an action of the driving section. Pisani also uses a detecting section (such as photocell 38) and independent control (column 4, lines 39-40) which also operates to control the correction section based on the positional information so as to

bring a positional relationship between the opposite side edges of the web closer to the predetermined positional relationship. Pisani also discloses a number of benefits and motivations for utilizing this invention; namely that the invention reduces the dimensions of the apparatus, reduces the need for operator involvement, and reduces ruffles in the fabric or web (see column 6, lines 7-19). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have utilized the correction section of Pisani in order to achieve the benefits of reduced dimensions of the apparatus, reduced need for operator involvement, and reduced ruffles in the fabric or web.

As to claim 5, Umebayashi discloses the steps of: placing an elastic member on a surface of the web; and forming a hole to be a leg hole in the web (see claim 2, which is word for identical).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 4 and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 2 of U.S. Patent No. US 6,913,664 in view of Pisani (US 3,759,198).

The claim to claim analysis is below; differences in the language are italicized.

US 6,913,664, claim 4	Instant Claim 1	Analysis
A method for producing a <i>disposable</i> worn article, comprising the steps of:	A method for producing a worn article, the method comprising the steps of:	Disposable adds virtually distinction, since it goes to the intended use of the final product produced by the method.
placing an absorbent on a surface of a web;	placing an absorbent <i>body</i> on a surface of a web;	It appears body adds very little here and is either identical or obvious.
folding the web in two so that opposite side edges of the web are brought close to each other or <i>laid on each other</i> ;	folding the web in two <i>in a folding section</i> so that opposite side edges of the web are close to or <i>aligned with each other</i> ;	In a folding section appears obvious, since it recites the element by its function. It's unclear if there is any possible difference in claim scope between "laid on each other" or "aligned with each other".

		The language of the claims appears to read on each other.
detecting a reference portion of the web to be used as a reference in the folding operation so as to generate positional information regarding a position of the detected reference portion;	detecting a reference portion of the web to be used as a reference in a folding operation to generate positional information regarding a position of the detected reference portion;	Nearly word for word identical, no practical difference in claim scope.
correcting a path of the web based on the positional information so that the opposite side edges of the folded web are in a predetermined positional relationship with respect to each other;	correcting a path of the web based on the positional information so that the opposite side edges of the folded web are in a predetermined positional relationship with respect to each other <i>by bringing a contact section into contact with the web in the folding section;</i>	The first clear difference. Word for word identical except for the italicized portions. US 6,913,664 does not recite " <i>by bringing a contact section into contact with the web in the folding section;</i> "
bonding portions of the folded web to each other <i>so as to form a bonded</i>	bonding portions of the folded web to each other to form a bonded portion;	Nearly word for word identical, no practical significance to "so as"

portion;		
and cutting the bonded web along the bonded portion.	and cutting the bonded web along the bonded portion.	Word for word identical.

Thus, US 6,913,664 does not claim or make obvious *by bringing a contact section into contact with the web in the folding section.*

However, Pisani discloses a correcting a path of the web based on the positional information so that the opposite side edges of the folded web are in a predetermined positional relationship with respect to each other *by bringing a contact section into contact with the web in the folding section* by use of a contact section (elements 45) which provided between an upstream end of the abutting member and the nipping member for contacting an inner surface and/or an outer surface of the web being folded in the V or U shape, a driving section (such as electromagnets 69 and driving reduction unit 63 and 64, and the associated subelements of Figure 3) for changing a state of contact of the contact section and/or the abutting member with the web, and that the control section for controlling an action of the driving section. Pisani also uses a detecting section (such as photocell 38) and independent control (column 4, lines 39-40) which also operates to control the correction section based on the positional information so as to bring a positional relationship between the opposite side edges of the web closer to the predetermined positional relationship. Pisani also discloses a number of benefits and motivations for utilizing this invention; namely that the invention reduces the dimensions of the apparatus, reduces the need for operator involvement, and reduces ruffles in the fabric or web (see column 6, lines 7-19). Therefore, it would have been obvious for one of ordinary skill in the

art at the time of the invention to have utilized the correction section of Pisani in order to achieve the benefits of reduced dimensions of the apparatus, reduced need for operator involvement, and reduced ruffles in the fabric or web.

As for claim 5, claim 2 of the US 6,913,644 patent recites "A method for producing a disposable worn article according to claim 1, comprising the steps of: placing an elastic member on the surface of the web; and forming a hole to be a leg hole in the web." This is word for word identical to claim 5 (except for the claim number recited).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (571) 272-1230 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the applicant can communicate by calling the Federal Relay Service at 1-866-377-8642 and giving the operator the above TDD number. The examiner can also be reached by E-mail at george.koch@uspto.gov in accordance with MPEP 502.03. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George R. Koch III/
Primary Examiner, Art Unit 1791

4/2/2009